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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,371	07/24/2003	Daniel B. Sachuk	249212022700	2455
25226	7590	04/05/2006		
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER MILLER, BRIAN E	
			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/627,371		SACHUK, DANIEL B.	
	Examiner		Art Unit	
	Brian E. Miller		2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 and 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/24/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-35 are pending.

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 12-19 & 29-35, in the reply filed on 3/17/06 is acknowledged.
2. Claims 1-11, 20-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/17/06.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "leader block adapted to be releasably attached to the take-up reel", as recited in claim 19, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The abstract of the disclosure is objected to because it does not reflect the elected invention, i.e., tape drive, and should be modified appropriately. Correction is required. See MPEP § 608.01(b).

Claim Objections

6. Claim 29 is objected to because of the following informalities: (a) Claim 29, line 1, the recitation of "the steps of" after the word "comprising" should be inserted appropriately. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 29-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. (a) Claim 29, second to last line, the phrase “increases the tape path” is indefinite. It is not readily apparent as to what structure within the claim this “increase” is with respect to; (b) claim 33, the phrases “the reel” and “the access window” lack proper antecedent basis; claim 35, similarly, the phrase “the access window” lacks antecedent basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 12-13, 15-19, 29-30, 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hu (US 6,246,542). (As per claim 12) Hu discloses, with respect to FIG. 2 mainly, a tape drive 89 with a storage cartridge 11 disposed therein, including: a storage cartridge housing 21, 23, 25 having: an access window 71, 73, a single supply reel 13 rotatably disposed within the storage cartridge housing and having storage tape 15 wound on the supply reel 13, and a guide surface, e.g, any one or more of elements 53, 55, disposed within the storage cartridge housing; and a tape drive having: at least a first guiding element (unnumbered-shown in FIG. 2 as the circular guide just outside the cartridge 11 adjacent element 31), a data transducer (not expressly shown, however, necessarily present- see col. 3, lines 7-11), and a take-up reel 91, wherein the storage tape extends from the supply reel to the guide surface before extending through the access window to the first guiding element, and the storage tape is guided within the tape drive adjacent a data transducer, and wound on the take-up reel, as described in Hu (see for

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example col. 3, lines 21-52); (as per claim 13) wherein the guide surface, any one or more of elements 53, 55, includes a rotatable surface; (as per claim 15) wherein the guide surface includes a contoured surface, i.e., rounded; (as per claim 16) wherein the storage cartridge housing includes “only a single opening” wherein the storage tape is accessible, i.e., one of 71 or 73. It is noted that since the claims’ preamble recites “comprising” the use of the reference to Hu having more than one opening is not precluded by the above limitation; (as per claim 17) wherein the data transducer includes at least one of a read head and a write head (see col. 3, line 9); (as per claim 18) wherein the guide surface 53, 55 is positioned within the storage cartridge housing to guide the storage tape away from the supply reel and then back to reengage the supply reel (see col. 2, lines 52-61) before extending to the access window, as clearly shown in FIG. 2; (as per claim 19) wherein the storage tape includes a leader block 67 adapted to be releasably attached to the take-up reel.

As the method claims, i.e., 29-30, 32-33, 35, define similar but broader limitations to the apparatus claims defined above, the method claims, in so far as they define clear method steps, they are rejected under the same grounds. With respect to claim 34, Hu is further considered to show that when streaming the storage tape, the storage tape becomes separated from the reel by a thin layer of air, as shown in the FIG.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 14, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu (US 6,246,542). For a description of Hu, see the rejection, *supra*. Hu remains silent as to the guide surface(s) having a stationary surface. While Hu discloses “rollers”, i.e., a rotatable surface, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the rollers of Hu with stationary guides. The motivation would have been: substituting rotating rollers with stationary rollers, would have been readily provided for through routine engineering design choice. For example, stationary rollers would have reduced manufacturing costs, as opposed to rotating rollers, and thus would have been a substitution within the knowledge of a skilled artisan.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure including US Patents to Todd et al (5,657,937) and Mewes et al (6,915,982) which are cited to show guide surface(s) in a tape cartridge to ease the reeling/unreeling of the tape from the reel.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (571) 272-7578. The examiner can normally be reached on M-TH 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Miller
Primary Examiner
Art Unit 2627

BEM
March 29, 2006